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09/607,843	06/30/2000	Kia Silverbrook	NPA063US	2333

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SILVERBROOK RESEARCH PTY LTD  
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BALMAIN, 2041  
AUSTRALIA

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/607,843

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

Narayanswamy Subramanian

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,8-31 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-31 and 36-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/18/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This is in response to communication dated March 10, 2005. Amendments to the specification and claims 8, 10, 12, 15, 18, 20, 21, 25-29 and 36-48 and cancellation of claims 4, 5, 7 and 32-35 have been entered. Claim 6 was withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claim in response to this office action. Rejections made under 35 USC § 112, second paragraph are withdrawn by the examiner in view of the amendments. Applicants on page 14 of their communication state that additional dependent claims 49 and 50 have been added, but the examiner has found no such claims in the Applicant's communication. Clarification is required. Claims 1-3, 8-31 and 36-48 are currently pending and have been examined. The rejections and response to arguments are stated below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

3. Claims 24, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 cites the limitation "The method of claim 1 or 5". There is no antecedent basis for this limitation because claim 5 has been cancelled. Claims 30 and 31 cite the limitation "The system of claim 29". There is no antecedent basis for these limitations. Appropriate correction/clarification is required.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 8-20, 24-31 and 36-43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al (US Patent 5,797,002) in view of Richards et al (US Patent 6,539,361 B1).

With reference to Claims 1 and 29, Patterson discloses a method and system of enabling financial transaction, the method including the steps of: providing the user with a form containing information relating to a financial transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form; receiving, in a computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing the indicating data using at least some of the coded data; and identifying, in the computer system and from the indicating data, at least one parameter relating to the financial transaction (See Patterson Column 13 line 20 – Column 15 line 55).

Patterson does not explicitly disclose the step where the user is a banking customer and the financial transaction is an online banking transaction. Richards discloses the step where the user is a banking customer and the financial transaction is an online banking

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transaction (See Richards Abstract, Column 1 lines 16-44, Column 2 line 67 – Column 3 line 54).

Both Patterson and Richards are concerned with providing means for conducting financial transactions. It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosures of Richards to the invention of Patterson. The combination of the disclosures taken as a whole suggests that online banking customers would have benefited from being able to use a form that makes banking easier.

With reference to Claims 2 and 30, Patterson discloses a method and system of claims 1 and 29 respectively, in which said at least one parameter relating to the financial transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone relative to which the sensing device is located, said at least one parameter (See Patterson Column 13 lines 32-45).

With reference to Claims 3 and 31, Patterson discloses a method and system of claims 2 and 29 respectively, including receiving, in the computer system, data regarding movement of the sensing device relative to the form, the sensing device sensing its movement relative to the form using at least some of the coded data; and identifying, in the computer system and from said movement being at least partially within said at least one zone, said at least one parameter of the financial transaction (See Patterson Column 13 lines 32-45).

With reference to Claims 8 and 36, Patterson discloses a method and system of claims 2 and 29 respectively, in which the parameter is an action parameter of the

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financial transaction, the method including effecting, in the computer system, an operation in respect of the action parameter (See Patterson Column 13 lines 20-32).

With reference to Claims 9 and 39, Richards discloses the step where the action parameter includes a request for information relating to banking services, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill (See Richards Column 1 lines 26-44)

With reference to Claim 10, Patterson discloses a method of claim 3, in which the parameter is an option parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, an operation associated with the option parameter (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 11 and 38, Richards discloses a method and system of claims 10 and 36 respectively, in which the option parameter is associated with one of a request for information relating to banking services, an order for checks, a request to stop checks, an application for a new account, an application for a loan, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, a payment of a bill, a request for a list of bill payments, an account, a currency, and a payee name (See Richards Column 1 lines 26-44).

With reference to Claims 12 and 13, Patterson discloses a method of claim 3, in which the parameter is a text parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation

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associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55).

With reference to Claims 14 and 39, the step where the text parameter is associated with at least one of a check amount, a payee name, a currency amount, a transfer amount, a payment amount, a payment date, and a check number is old and well known in the banking art. These steps allow a checking transaction to be identified. With reference to Claims 15 and 16, Patterson discloses a method of claim 3, in which the parameter is an authorization parameter of the financial transaction, the method including identifying, in the computer system, that the user has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the user (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 15 line 55). The verifying step is inherent in the disclosure of Patterson.

With reference to Claims 17 and 40, Richards discloses a method and system of claims 16 and 36 respectively, in which the authorization parameter is associated with authorization for at least one of access to account information, withdrawal of funds, transfer of funds, payment of a bill, modification of a bill payment, deletion of a bill payment, stopping of checks, and ordering of checks (See Richards Column 1 lines 26-44 and Column 3 lines 1-54).

With reference to Claims 18, 19 and 41, Richards and Patterson combined disclose a method and system of claims 3 and 36 respectively, as discussed above.

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Richards and Patterson combined do not explicitly teach the step in which the parameter is a picture parameter of the banking transaction, an operation associated with the picture parameter which in turn is associated with a design for customer's checks.

Official notice is taken that having a picture parameter of the banking transaction, an operation associated with the picture parameter, which in turn is associated with a design for customer's checks is old and well known in the art. These steps help in timely identification of the parameter and also minimize the text necessary to identify the item (A picture is sometimes worth a thousand words).

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the combined disclosures of Richards and Patterson. The combination of the disclosures taken as a whole suggests that users would have benefited from the ease in identifying the parameter of interest.

With reference to Claim 20, Richards discloses a method of claim 1, in which the form contains information relating to at least one of information relating to banking services, a request for an account history, a request for a withdrawal of funds, a request for a transfer of funds, a request for an account balance, and a payment of a bill (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 16 line 55).

With reference to Claims 24, 26, 47 and 43, Patterson discloses a method and system of claims 1 and 29 respectively, including retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (See Patterson Column 29 line 57 – Column 30 line 47) and in which the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method



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includes monitoring, in the computer system, said identity (See Patterson Column 13 line 20 – Column 16 line 55).

With reference to Claims 25 and 27, Patterson discloses a method of claim 1, including distributing a plurality of the forms using communications protocols (See Patterson Column 19 lines 11-27 and Column 23 lines 44-47) and including providing all required information relating to the financial transaction in the form to eliminate the need for a separate display device (See Patterson Figures 4, 8, 11 and Column 13 line 20 – Column 16 line 55). The communications protocols are interpreted to include a mixture of multicast and pointcast communications protocols.

6. Claims 21-23, 44-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Jr. et al (US Patent 5,797,002) in view of Richards et al (US Patent 6,539,361 B1) further in view of Sekendur (WO 97/22959)

With reference to Claims 21-23, 44-46 and 48, Patterson discloses a method and apparatus of claims 1 and 29 respectively.

Patterson does not explicitly teach the steps of printing the form on demand, thereby allowing a sensing device to sense coded data provided on the printed form, including printing the form on a surface of a surface-defining means and, at the same time that the form is printed, printing the coded data on the surface where the coded data to be substantially invisible in the visible spectrum and a form printed on multiple pages, the printer includes a binding means for binding the pages.

Sekendur discloses the steps of printing the form on demand, thereby allowing a sensing device to sense coded data provided on the printed form, including printing the form on a surface of a surface-defining means and, at the same time that the form is

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printed, printing the coded data on the surface where the coded data to be substantially invisible in the visible spectrum (See Sekendur pages 8-10). Official notice is taken that printing on multiple pages and binding the pages is old and well known in the art. Printing on multiple pages and binding them helps keep the records together.

Both Sekendur and Patterson are concerned with the problem of making it easier for a user to input and read data for processing by a computer. It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the disclosures of Patterson. The combination of the disclosures taken as a whole suggests that users would have benefited from the time savings over a manual process and from keeping the records together by printing on multiple pages and binding them.

#### *Response to Arguments*

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the form is provided on a substrate utilizing appropriate markings") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed features namely providing the user with a form containing information relating to a financial transaction, the form including coded data indicative of an identity of the form and of at least one reference point of the form; receiving, in a computer system, indicating data from a sensing device regarding the identity of the form and a position of the sensing device relative to the form, the sensing device, when placed in an operative position relative to the form, sensing the indicating data using at least some of the coded data; and identifying, in the

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computer system and from the indicating data, at least one parameter relating to the financial transaction are disclosed by Patterson (See Patterson Column 13 line 20 – Column 15 line 55)

In response to applicant's argument that Patterson does not describe providing coded data on the form, the examiner disagrees. The forms contain data like "DAY", "GTC" etc which are codes for order parameters like "Day Order", "Good till cancelled" etc. There is nothing in the claim that precludes the codes to be in text form.

Similarly in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a sensing device which generates indicating data when it is placed in an operative position relative to the form") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. It is clear from Patterson's disclosure that data is received by the computer system when pen-type input devices are used (See Patterson Column 8 lines 58-67).

Applicant's other arguments with respect to claims 1-3, 8-31 and 36-48 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

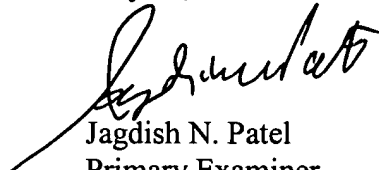
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

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May 19, 2005



Jagdish N. Patel  
Primary Examiner